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| 09/445,617      | 12/08/1999  | ALAIN LEMIEUX        | 7218-000002         | 1168             |

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| EXAMINER |
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JUSKA, CHERYL ANN

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| ART UNIT | PAPER NUMBER |
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1771

DATE MAILED: 07/30/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/445,617

Applicant(s)

LEMIEUX, ALAIN

Examiner

Cheryl Juska

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 12 March 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-22 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 6.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## DETAILED ACTION

### *Response to Amendment*

1. Amendment A, submitted as Paper No. 8 on March 12, 2002, has been entered. The specification and claims 1-6 and 8-10 have been amended as requested. New claims 12-22 have been added. Thus, the pending claims are 1-22.
2. Amendment A is sufficient to withdraw the 112, 2<sup>nd</sup> rejections set forth in sections 7 and 9-12.

### *Claim Rejections - 35 USC § 112*

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:  

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
4. Claims 1, 9, and 12 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
5. Claims 1 and 9 are rejected for the use of the relative terms "closely," "densely," "firm," and "fine." This rejection is maintained from the last Office Action section 8. New claim 12 is similarly rejected for the use of the relative terms including "closely resemble."
6. Claim 9 is also rejected for the use of the phrase "sand or similar particulate material." It is unclear what the scope of the "similar" material is. Is it similar in size, color, shape, density, or composition?

***Claim Rejections - 35 USC § 103***

7. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

8. Claims 1 and 10 stand rejected under 35 U.S.C. 103(a) as being unpatentable over US 4,505,960 issued to Leffingwell in view of US 4,830,798 issued to Maeda, as set forth in section 14 of the last Office Action.

New claims 12 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over US 4,505,960 issued to Leffingwell in view of US 4,830,798 issued to Maeda.

9. Claims 2-8 stand rejected under 35 U.S.C. 103(a) as being unpatentable over the cited Leffingwell and Maeda patents, as applied to claim 1 above, and in further view of US 4,931,477 issued to Shiiki et al. and US 5,035,275 issued to Yamaguchi, as set forth in section 15 of the last Office Action.

New claims 13-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over the cited Leffingwell and Maeda patents, as applied to claim 1 above, and in further view of US 4,931,477 issued to Shiiki et al. and US 5,035,275 issued to Yamaguchi.

10. Claim 9 stands rejected under 35 U.S.C. 103(a) as being unpatentable over the cited Leffingwell and Maeda patents, as applied to claim 1 above, and in further view of US 5,373,667 issued to Lemieux, as set forth in section 16 of the last Office Action.

Claims 20 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over the cited Leffingwell and Maeda patents, as applied to claim 1 above, and in further view of US 5,373,667 issued to Lemieux.

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11. Claim 11 stands rejected under 35 U.S.C. 103(a) as being unpatentable over the cited Leffingwell and Maeda patents, as applied to claim 1 above, and in further view of US 5,820,475 issued to Luna, as set forth in section 17 of the last Office Action.

***Response to Arguments***

12. Applicant's arguments filed with Amendment B have been fully considered but they are not persuasive.

13. Applicant's traversal of the standing 112, 2<sup>nd</sup> rejection has been found unpersuasive in that there is nothing on record establishing what one of ordinary skill in the art would define as "typical" features of a "natural grass surface," as asserted by Applicant (Amendment B, page 8, lines 7-13). The relative terms are not defined by the claim and the specification does not provide a standard for ascertaining the requisite degree. Additionally, Applicant's argument is directed to typical features of natural grass surface, while the present invention is directed to artificial grass. Are the features the same? To what degree?

14. With respect to the prior art rejections, Applicant argues that Leffingwell does not teach the claimed single layer underpad, but rather a layered pad which addresses the need for improvements in shock absorbance (Amendment B, paragraph spanning pages 9-10). In response, it is first noted that Leffingwell was not relied upon to the underpad material, but merely to back up the known basic construction (i.e., pile layer and underpad) recited in the Jepson claim format and to teach the important features of said underpad. Thus, the fact that Leffingwell discloses a multi-layered underpad is irrelevant to the above rejection. Secondly, Applicant is arguing the reference individually. One cannot show nonobviousness by attacking

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references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

15. With respect to Applicant's assertion that Maeda does not teach a propylene bead material in combination with an artificial grass (Amendment B, page 10, lines 5-19), it is reiterated that the above rejection is a combination rejection under 103. As such, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

16. In response to Applicant's assertion that Leffingwell does not teach a pad thickness within the claimed range of up to 12 inches as recited in claim 2 (Amendment B, page 11, lines 1-3), it is reiterated that Leffingwell teaches a pad thickness ranging from 0.23-2 inches, which clearly falls within the claimed range of 0.25-12 inches. The reference need not teach a thickness of 12 inches.

17. Applicant's remaining arguments addressing the Shiiki, Yamaguchi, Lemieux, and Luna references, once again falls short of being persuasive in that said arguments address the references individually rather than the combination of said references. One cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

18. With respect to new claim 12-22, it is noted that said claims contain limitations analogous to claims 1-10. Claims 12-22 differ from claims 1-10 by the preamble limitation of

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intended use. a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963).

19. The recitation "a synthetic rooftop or patio or deck surface" has not been given patentable weight because the recitation occurs in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951). Additionally, it is noted that a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963).

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**Conclusion**

20. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

21. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Cheryl Juska whose telephone number is 703-305-4472. The Examiner can normally be reached on Monday-Friday 10am-6pm.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Terrel Morris can be reached on 703-308-2414. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

cj  
July 29, 2002

  
**CHERYL A. JUSKA**  
**PRIMARY EXAMINER**